

REMARKS

Claims 1-15 were pending in this application.

Claims 1-15 have been rejected.

Claims 1, 3, 4, 6, 7, 9, 10, 12 and 14 have been amended. Claims 6 and 10 have been amended solely to correct typographical errors.

Claims 1-15 remain pending in this application.

Reconsideration and full allowance of Claims 1-15 are respectfully requested.

I. REJECTION UNDER 35 U.S.C. § 103

The Office Action rejects Claims 1-15 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,628,891 B1 to Vantalon et al. ("*Vantalon*") in view of U.S. Patent Application Publication No. 2003/0103532 A1 to Bertram et al. ("*Bertram*") and U.S. Patent Application Publication No. 2002/0101991 A1 to Bacon et al. ("*Bacon*"). These rejections are respectfully traversed.

In *ex parte* examination of patent applications, the Patent Office bears the burden of establishing a *prima facie* case of obviousness. (MPEP § 2142; *In re Fritch*, 972 F.2d 1260, 1262, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992)). The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention is always upon the Patent Office. (MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984)). Only when a *prima facie* case of obviousness

is established does the burden shift to the applicant to produce evidence of nonobviousness. (MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993)). If the Patent Office does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of a patent. (*In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Grabiak*, 769 F.2d 729, 733, 226 U.S.P.Q. 870, 873 (Fed. Cir. 1985)).

A *prima facie* case of obviousness is established when the teachings of the prior art itself suggest the claimed subject matter to a person of ordinary skill in the art. (*In re Bell*, 991 F.2d 781, 783, 26 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1993)). To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. (MPEP § 2142).

Vantalon recites a set-top box and Conditional Access Module (CAM). (*Figure 4 and Col. 6, Lines 8-11*). The set top box includes in-band (IB) and out-of-band (OOB) receivers that receive signals from a communications network. (*Col. 6, Lines 13-21*). The outputs of the receivers are coupled to a transport stream co-processor in the CAM. (*Col. 6, Lines 22-23*). The CAM supplies

digital video and digital audio to a decoder in the set top box via a transport stream and communicates out-of-band information to a microprocessor in the set top box via an extended channel. (*Col. 6, Lines 33-65*).

Regarding independent Claims 1, 4, 7 and 12, the Office Action acknowledges that *Vantalón* fails to disclose “a system or method where the CAM sends the OOB data as packets” as recited in Claim 1. (*Office Action, Page 2, Last paragraph*). The Office Action then asserts that *Bertram* discloses this element of Claim 1 and that it would be obvious to combine *Vantalón* with *Bertram*. (*Office Action, Page 3, First full paragraph*).

Bertram recites an interactive information distribution system containing a distribution network connecting service provider equipment to subscriber equipment. (*Figure 1 and paragraph [0018]*). Content data and asset data are sent as interleaved, or multiplexed, packets from the service provider equipment through the distribution network to subscriber equipment via in-band channels. (*Paragraphs [0020] and [0034]*). NULL transport packets are interspersed between content data packets, to form “place holders” for asset data packets and some or all of the NULL packets are replaced with asset data packets prior to transmitting the resulting transport stream. (*Paragraph [0010]*).

As amended, independent Claims 1, 4, 7 and 12 each recite inserting out-of-band transport stream packets in existing gaps between consecutive in-band transport stream packets. In contrast, *Bertram* describes inserting NULL packets between content data packets, to act as place holders for subsequent replacement by asset data packets prior to transmission. As such, the proposed

combination of the *Vantalon*, *Bertram* and *Bacon* references fails to teach all the limitations of the Applicant's invention as claimed. Accordingly, the Applicant respectfully requests withdrawal of the § 103 rejections and full allowance of independent Claims 1, 4, 7 and 12 (and their dependent claims).

II. CONCLUSION

For the reasons given above, the Applicant respectfully requests reconsideration and full allowance of all pending claims and that this application be passed to issue.

SUMMARY

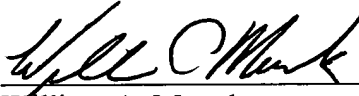
If any outstanding issues remain, or if the Examiner has any further suggestions for expediting allowance of this application, the Applicant respectfully invites the Examiner to contact the undersigned at the telephone number indicated below or at *wmunck@munckbutrus.com*.

The Commissioner is hereby authorized to charge any additional fees connected with this communication (including any extension of time fees) or credit any overpayment to Deposit Account No. 50-0208.

Respectfully submitted,

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Date: 07/12/06



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